

U.S. Patent Application No. 09/870,296  
Reply to Office Action dated June 30, 2006

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PATENT  
450100-03302

SEP 27 2006

**REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

**I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-6 are currently pending. Claims 1 and 4, which are independent, are hereby amended. Claim 7 has been canceled without prejudice or disclaimer of subject matter. No new matter has been introduced. Support for this amendment is provided throughout the Specification, specifically on pages 9-11. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. REJECTIONS UNDER 35 U.S.C. §103(a)**

Claims 1-6 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,311,011 to Kuroda (hereinafter, merely "Kuroda") in view of U.S. Patent No. 5,774,170 to Hite et al. (hereinafter, merely "Hite").

Claim 1 recites, *inter alia*:

"A recording system for recording and/or reserving a broadcast program, comprising:

...user information management means for storing user information about each requesting origin, wherein a recording substitution means obtains advertising information appropriate for a user attribute of the requesting origin via said connection means and inserting said information in a recorded program,

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wherein said recording system is charged for program reservation substitution services at a metered rate corresponding to recording time." (emphasis added)

As understood by Applicants, Kuroda relates to a device recorder for recording and playing data streams of audio, video and related information, as well as a device for displaying an Electronic Program Guide (EPG).

As understood by Applicants, Hite relates to an electronic system and process for enhancing advertising by delivering TV and radio commercials targeted to individual viewer's based on desires and needs.

Applicants respectfully submit that Kuroda and Hite, taken alone or in combination, fail to teach or suggest the features of claim 1. Specifically, Applicants submit that there is no teaching or suggestion of a recording system for recording and/or reserving a broadcast program wherein said recording system is charged for program reservation substitution services at a metered rate corresponding to recording time, as recited in claim 1.

Furthermore, Applicants submit that not only does Kuroda and Hite, taken alone or in combination, fail to teach or suggest the claimed features, but the combination of Kuroda and Hite is improper because it lacks motivation. Applicants submit that one skilled in the art would not be motivated to combine a device for recording video signals and for displaying an Electronic Program Guide, as disclosed in Kuroda, with a system and method for delivering targeted advertisements to consumers, as disclosed in Hite. Indeed, the recitation of "user information management means for storing user information about each requesting origin, wherein a recording substitution means obtains advertising information appropriate for a user attribute of the requesting origin via said connection means and inserting said information in a recorded program" does not provide a suggestion to combine Kuroda and Hite. Applicants respectfully submit that the combination of Kuroda and Hite is the result of improper hindsight

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using Applicants' claimed invention as a blueprint. Applicants also respectfully submit that picking and choosing particular features from divergent patents is improper and such a combination may not be used as a basis of rejection.

For the above-stated reasons, Applicants submit that the combination of Kuroda and Hite is improper and the rejection should be withdrawn.

Therefore, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1, claim 4 is also believed to be patentable.

Therefore, Applicants submit that independent claims 1 and 4 are patentable.

### **III. DEPENDENT CLAIMS**

The other claims are dependent from independent claim 1, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

### **CONCLUSION**

In the event the Examiner disagrees with any of the statements appearing above with respect to the disclosures in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate the portion, or portions, of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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